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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,331	12/12/2001	Michael T. Milbocker	PRAXIS-5	9980
7590	06/16/2005	EXAMINER		
FUBARA, BLESSING M			ART UNIT	
1618			PAPER NUMBER	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/020,331	<b>Applicant(s)</b> MILBOCKER, MICHAEL T.
	<b>Examiner</b> Blessing M. Fubara	<b>Art Unit</b> 1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 January 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14, 17-30 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14, 17-30 and 40-48 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/10/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

Examiner acknowledges receipt of both compliant and non-compliant claims amendment filed 02/11/05 and 01/12/05 respectively. Consideration is based on the complaint amendment. Examiner further acknowledges receipt of amendment to the specification and remarks, all filed 01/12/05 and IDS filed 03/10/2005.

### ***Response to Amendment to the Specification***

The amendment to the specification is non-compliant because there are no markings in the amended paragraphs that show what is deleted or replaced or added. Please refer to MPEP 714 R-2 for the manner of making amendments, also see excerpt below:

#### ***37 CFR 1.121. Manner of making amendments in application.***

- (a) Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.***
- (b) Specification. Amendments to the specification, other than the claims, computer listings (§1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.***
- (1) Amendment to delete, replace, or add a paragraph. Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:***

- (i) *An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;*
- (ii) *The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;*
- (iii) *The full text of any added paragraphs without any underlining; and;*
- (iv) *The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.*

(2) *Amendment by replacement section. If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:*

- (i) *A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;*

(ii) *A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.*

(3) *Amendment by substitute specification . The specification, other than the claims, may also be amended by submitting:*

- (i) *An instruction to replace the specification; and*
- (ii) *A substitute specification in compliance with § 1.125(b) and (c).*

(4) *Reinstatement of previously deleted paragraph or section . A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.*

(5) *Presentation in subsequent amendment document. Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.*

Applicant is respectfully requested to please provide amendment that satisfies the requirements of MPEP 714 R-2. Also, the pages cited for the respective paragraph numbers in the published application do not correspond to the pages of the published application. For example paragraphs 0008 and 0012 appear on page 1 of the publication.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 and 30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for “about 70%” and “about 75%”. The scope of the protection sought is not commensurate with the enabling disclosure.
3. The rejection of claims 1-14,17-30 and 44-48 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the amendment and remarks.

***Claim Rejections - 35 USC § 102***

4. Claims 1-3 and 8 remain rejected under 35 U.S.C. 102(b) as being anticipated by Muller et al. (US 5,624,972).

Applicant argues that Muller differs from the instant claims in the following respects:

- a) Muller’s prepolymers are hydrophobic and not hydrophilic as is the case with applicant’s prepolymer.
- b) The activated polymers of Muller precipitate out of solution while those of applicant’s do not precipitate out of the solution.

c) Instant paragraph 19 indicates that commercial prepolymers are called "hydrophilic" even if they can absorb 10% water or less and that the ratio of PE to PO is critical to the formation of hydrogel. The PE provides the necessary hydrophilic nature while the PO provides hydrogel strength and a PO of about 10% to 30% is preferred.

5. Applicant's arguments filed 01/12/05 have been fully considered but they are not persuasive.

Muller does not disclose its prepolymers as hydrophobic; propylene oxide monomers do not dominate the prepolymer of Muller.

Muller does not talk about the prepolymers precipitating out of solutions.

The oxyethylene contents of Muller's prepolymers range from 10-80% and copolymer that have up to 50% oxyethylene content are applicable in Muller and polypropylene oxide do not represent the dominate species in the copolymer of PE and PO (column 4, line 46 to column 5 line 60). PE and PO contribute to the prepolymer of Muller.

***Claim Rejections - 35 USC § 103***

6. Claim 4-7, 9-14, 17-30 and 40-48 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Muller et al. (US 6,624,972).

Applicant argues that at least about 70% EO and 10-30% PO is not disclosed by Muller; and that Muller does not disclose 10-30% PO.

7. Applicant's arguments filed 01/12/05 have been fully considered but they are not persuasive.

Muller discloses a prepolymer that contains 80 EO and 20 PO and specifically about 70% does not have support in the specification. 80 is at least 70.

***Specification***

The amendment to the specification does not comply with the amendment practice set forth in MPEP 714 R-2. The objection will be withdrawn once the amendment complies with the stipulations of MPEP 714 R-2.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

(bf)  
Blessing Fubara  
Patent Examiner  
Tech. Center 1600

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600